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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,363	07/24/2006	Stephanie Blanche	3712036.00717	8221
29157 K&L Gates LLP P.O. Box 1135 CHICAGO, IL 60690	7590 03/17/2011		EXAMINER GWARTNEY, ELIZABETH A	
			ART UNIT 1781	PAPER NUMBER
			NOTIFICATION DATE 03/17/2011	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

# Office Action Summary

**Application No.**

10/595,363

**Applicant(s)**

BLANCHE ET AL.

**Examiner**

ELIZABETH GWARTNEY

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 February 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4,5 and 7-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-5 and 7-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on February 1, 2011 has been entered.
2. **Claims 1-2, 4-5 and 7-21** are pending.

### **Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. **Claims 1-2, 4-5 and 7-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hahn (US 6,217,929).

Regarding **claims 1-2 and 9-12**, Hahn discloses a batter composition that is spoonable (yield stress of 100 to 1500 Pa) at refrigeration temperature and has a refrigerated shelf life of at least about 75 days (Abstract, C2/L6-29). Hahn discloses that the term “batter” is intended to include any flour-based batter or dough and depending on the exact kinds and proportions of the ingredients used, the compositions of the invention could take the form of either a traditional batter or a dough-both encompassed by the invention (C2/L17-29). Hahn discloses batter comprising flour, sugar, water, in an amount ranging from about 10% to 30% by weight, chocolate particles and/or butter (i.e. fat in the form of discrete particles), and having a water activity (Aw) of about 0.82 to 0.88 (C2/L56-C4/L12, C5/L21-28, C6/L8-10).

Given Hahn discloses a batter mixture substantially similar in composition to that presently claimed, including fat in the form of discrete particles (i.e. chocolate particles and/or butter), and that could take the form of a traditional batter, it necessarily follows that the mixture would have a flowability when measured by a Bostwick Consistometer after 40 seconds of between 6 cm and about 12 cm at a temperature of 8°C.

While Hahn discloses batter comprising about 5% to 20% by weight shortening or oil (see butter is also a useful fat and can provide flavor to the batters - C4/L9-12) and chocolate

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particles (C5/L21-28), the reference does not explicitly disclose that the chocolate particles and/or butter represent at least 60%, 70%, 80%, 90%, or 95% of the total fat contained in the batter mixture. As chocolate and/or butter flavor and product texture (i.e. density) are variables that can be modified, among others, by adjusting the ratio of chocolate particles and/or butter in the total fat of the product, the precise amount of chocolate particles and/or butter in the mixture would have been considered a result effective variable by one of ordinary skill in the art at the time of the invention. As such, without showing unexpected results, the claimed ratio of chocolate particles and/or butter in the total fat of the mixture cannot be considered critical. Accordingly, one of ordinary skill in the art at the time the invention was made would have optimized, by routine techniques, the amount of chocolate particles and/or butter making up the total fat in the batter mixture of Hahn to obtain the desired balance between baked product density, chocolate flavor, and butter flavor (In re Boesch, 617 F.2d. 272, 205 USPQ 215 (CCPA 1980)), since it has been held that where the general conditions of the claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. (In re Aller, 105 USPQ 223).

While Hahn disclose a batter mixture comprising discrete chocolate particles, the reference does not explicitly disclose that the particles comprises a mean cross section of about 0.5 mm to about 3.0 mm. As product texture is a variable that may be modified, among others, by adjusting the size of the discrete particles of chocolate, the precise mean cross section would have been considered a result effective variable by one of ordinary skill in the art at the time of the invention. As such without showing unexpected results, the claimed chocolate particle size cannot be considered critical. Accordingly, one of ordinary skill in the art at the time the

invention was made would have optimized, by routine techniques, the size of the chocolate particles, i.e. mean cross section, in the batter mixture of Hahn to obtain the desired product texture (In re Boesch, 617 F.2d. 272, 205 USPQ 215 (CCPA 1980)), since it has been held that where the general conditions of the claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. (In re Aller, 105 USPQ 223).

Regarding **claims 4-5 and 13-18**, Hahn discloses a method for preparing a batter comprising using a source of fat in the form of discrete particles (i.e. chocolate particles and/or butter) mixed in a spoonable refrigerated continuous phase comprising flour, sugar, water, in an amount ranging from about 10% to 30% by weight (Abstract, C2/L56-C4/L12, see mixing is carried out under refrigerated conditions and the order of addition of ingredients is not critical-C5/L21-38). Hahn discloses that the term “batter” is intended to include any flour-based batter or dough and depending on the exact kinds and proportions of the ingredients used, the compositions of the invention could take the form of either a traditional batter or a dough-both encompassed by the invention (C2/L17-29). Hahn discloses that the batter of the invention has a yield stress value of about 100 to 500 Pa.

Given Hahn discloses a batter composition that is substantially similar to that presently claimed, since Hahn disclose that refrigerated batter is spooned from the container into a baking pan (C6/L14-16) and has the form of a traditional batter, it is clear that that batter would intrinsically exhibit the recited flowability characteristics.

While Hahn discloses batter comprising about 5% to 20% by weight shortening or oil (see butter is also a useful fat and can provide flavor to the batters - C4/L9-12) and chocolate particles (C5/L21-28), the reference does not explicitly disclose that the chocolate particles

and/or butter represent at least 60%, 70%, 80%, 90%, or 95% of the total fat contained in the batter mixture. As chocolate and/or butter flavor and product texture (i.e. density) are variables that can be modified, among others, by adjusting the ratio of chocolate particles and/or butter in the total fat of the product, the precise amount of chocolate particles and/or butter in the mixture would have been considered a result effective variable by one of ordinary skill in the art at the time of the invention. As such, without showing unexpected results, the claimed ratio of chocolate particles and/or butter in the total fat of the mixture cannot be considered critical. Accordingly, one of ordinary skill in the art at the time the invention was made would have optimized, by routine techniques, the amount of chocolate particles and/or butter making up the total fat in the batter mixture of Hahn to obtain the desired balance between baked product density, chocolate flavor, and butter flavor (In re Boesch, 617 F.2d. 272, 205 USPQ 215 (CCPA 1980)), since it has been held that where the general conditions of the claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. (In re Aller, 105 USPQ 223).

While Hahn disclose a batter mixture comprising discrete chocolate particles, the reference does not explicitly disclose that the particles comprises a mean cross section of about 0.5 mm to about 3.0 mm. As product texture is a variable that may be modified, among others, by adjusting the size of the discrete particles of chocolate, the precise mean cross section would have been considered a result effective variable by one of ordinary skill in the art at the time of the invention. As such without showing unexpected results, the claimed chocolate particle size cannot be considered critical. Accordingly, one of ordinary skill in the art at the time the invention was made would have optimized, by routine techniques, the size of the chocolate

particles, i.e. mean cross section, in the batter mixture of Hahn to obtain the desired product texture (In re Boesch, 617 F.2d. 272, 205 USPQ 215 (CCPA 1980)), since it has been held that where the general conditions of the claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. (In re Aller, 105 USPQ 223).

Regarding **claim 7**, Hahn discloses a method for making baking goods comprising the steps of: (a) providing a batter comprising water in an amount ranging from about 10% to 30% by weight, flour and sugar, which has a refrigerated shelf life of at least about 75 days, having a Aw of between 0.82 to 0.88 and chocolate particles and/or butter (i.e. source of fat present in the form of discrete particles) distributed in the mixture; (b) adding the batter to a pan; (c) baking the batter; (d) and obtaining a fully cooked baked food that is high and fluffy.

Given Hahn discloses a batter mixture substantially similar in composition to that presently claimed, including fat in the form of discrete particles (i.e. chocolate particles and/or butter) and that is in the form of a traditional batter, it is clear that the mixture would intrinsically display the recited flowability characteristics.

Given Hahn discloses a method for making a baked good substantially similar to the present invention, it necessarily follows that the baked good would have a fondant interior as presently claimed.

While Hahn discloses batter comprising about 5% to 20% by weight shortening or oil (see butter is also a useful fat and can provide flavor to the batters - C4/L9-12) and chocolate particles (C5/L21-28), the reference does not explicitly disclose that the chocolate particles and/or butter represent at least 60% of the total fat contained in the batter mixture. As chocolate and/or butter flavor and product texture (i.e. density) are variables that can be modified, among



others, by adjusting the ratio of chocolate particles and/or butter in the total fat of the product, the precise amount of chocolate particles and/or butter in the mixture would have been considered a result effective variable by one of ordinary skill in the art at the time of the invention. As such, without showing unexpected results, the claimed ratio of chocolate particles and/or butter in the total fat of the mixture cannot be considered critical. Accordingly, one of ordinary skill in the art at the time the invention was made would have optimized, by routine techniques, the amount of chocolate particles and/or butter making up the total fat in the batter mixture of Hahn to obtain the desired balance between baked product density, chocolate flavor, and butter flavor (In re Boesch, 617 F.2d. 272, 205 USPQ 215 (CCPA 1980)), since it has been held that where the general conditions of the claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. (In re Aller, 105 USPQ 223).

While Hahn disclose a batter mixture comprising discrete chocolate particles, the reference does not explicitly disclose that the particles comprises a mean cross section of about 0.5 mm to about 3.0 mm. As product texture is a variable that may be modified, among others, by adjusting the size of the discrete particles of chocolate, the precise mean cross section would have been considered a result effective variable by one of ordinary skill in the art at the time of the invention. As such without showing unexpected results, the claimed chocolate particle size cannot be considered critical. Accordingly, one of ordinary skill in the art at the time the invention was made would have optimized, by routine techniques, the size of the chocolate particles, i.e. mean cross section, in the batter mixture of Hahn to obtain the desired product texture (In re Boesch, 617 F.2d. 272, 205 USPQ 215 (CCPA 1980)), since it has been held that

where the general conditions of the claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. (In re Aller, 105 USPQ 223).

Regarding **claim 8**, Hahn discloses all of the claim limitations as set forth above but does not disclose that the source of fat is hydrogenated palm oil (C3/L61-C4/L12, C5/L21-27). Given that Hahn et al. disclose that a source of fat is chocolate particles, butter or shortening including palm oil, which are solid at room temperature, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used any form of a fat that is solid at room temperature, including hydrogenated palm oil, and arrive at the invention as presently claimed.

Regarding **claims 19-21**, Hahn discloses all of the claim limitations as set forth above. While Hahn discloses chocolate particles, the reference does not explicitly disclose that the volume of the chocolate particles, is between  $0.01 \text{ mm}^3$  and  $80 \text{ mm}^3$ . As product texture is a variable that may be modified, among others, by adjusting the volume of the discrete particles of chocolate, the precise chocolate particle volume would have been considered a result effective variable by one of ordinary skill in the art at the time of the invention. As such without showing unexpected results, the claimed chocolate particle volume cannot be considered critical. Accordingly, one of ordinary skill in the art at the time the invention was made would have optimized, by routine techniques, the chocolate particle volume in the batter mixture of Hahn to obtain the desired product texture (In re Boesch, 617 F.2d. 272, 205 USPQ 215 (CCPA 1980)), since it has been held that where the general conditions of the claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. (In re Aller, 105 USPQ 223).

### **Response to Arguments**

7. Applicants' arguments filed February 1, 2011 have been fully considered but they are not persuasive.

Applicants explain that they have "surprisingly found that the provision of a source of fat in the form of discrete particles distributed in the continuous phase of refrigerated mixture comprising flour, water and sugar, in accordance with the present claims, makes it possible not only to conserve the fluidity of the mixture at temperature corresponding to the usual refrigeration temperatures, but also to obtain a cooked pastry product that has desired organoleptic qualities."

Applicants argue that Hahn fails to disclose "ready-to-use" mixtures that are fluid and stable for several weeks in the refrigerated form and wherein the mixture has a flowability when measured by a Bostwick Consistometer after 40 seconds of between about 6 cm and about 12 cm at a temperature of 8° C. Instead, Applicants submit that Hahn is directed to a flour based batter that is "spoonable" at refrigeration temperatures. Applicants note that Hahn expressly states that "spoonable" means that "the consumer can readily spoon or scoop the batter from the container." In contrast, Applicants note that the present claims require a "fluid" batter wherein "fluid" means that the mixture can be poured from its packaging" and "can flow by itself without any excessive external constraint."

Applicants note that Hahn discloses that the dough of his invention is "thicker and more viscous than conventional batters." Applicants argue that because Hahn discloses batters that are more viscous than conventional batters, the batters are not "fluid" and "pourable" as characterized by the presently claimed Bostwick consistency.

Here, given Hahn disclose a flour based mixture, which takes the form of a traditional batter (C2/L24-25), comprising water in an amount ranging from about 10% to 30% by weight, flour and sugar, which has a refrigerated shelf life of at least about 75 days, having a Aw of between 0.82 and 0.88 and chocolate particles and/or butter distributed in the mixture, one of ordinary skill in the art would have expected the batter to exhibit a Bostwick consistency in the range presently claimed. Further, while Hahn discloses batters that are more viscous than conventional batters, this does not mean that the batters are not "fluid," "pourable", or wouldn't display the presently claimed Bostwick consistency. One of ordinary skill in the art would appreciate that a batter "more viscous than traditional batters" could be "fluid" (i.e. "can be poured from its packaging" and "can flow by itself with any excessive external constraint") and exhibit Bostwick consistency within the broad range presently claimed.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELIZABETH GWARTNEY whose telephone number is (571)270-3874. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ELIZABETH GWARTNEY/

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